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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,804	09/04/2003	Jonathan Helitzer	HSDO-P01-002	7117
28120	7590	04/02/2008	EXAMINER	
ROPES & GRAY LLP PATENT DOCKETING 39/41 ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			NGUYEN, TRAN N	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/655,804	Applicant(s) HELITZER ET AL.	
	Examiner Tran Nguyen	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :03/24/2005, 09/21/2006, 11/03/2006, 12/04/2006, 05/11/2007, 02/22/2008, 03/10/2008.

DETAILED ACTION

Notice to Applicant

This communication is in response to the communication filed 03/10/2008.

Pending claim(s): 54-72. Cancelled claim(s): 1-53. New claim(s): 54-72.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 03/24/2005, 09/21/2006, 11/03/2006, 12/04/2006, 05/11/2007, 02/22/2008, 03/10/2008 is entered and considered by Examiner.

Drawings

The drawings were received on 02/14/2004. These drawings are acceptable.

Response to Amendment

The preliminary amendment filed 12/08/2006 is hereby entered and considered.

Claim Objections

Claim 55 objected to because of the following informalities: "a industry".

Claim 56 objected to because of the following informalities: "SIC". The use of acronyms in a claim may subject the claim to alternate interpretations.

Appropriate correction is requested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 58 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 58 recites the limitation "the usage". There is insufficient antecedent basis for this limitation in the claim.

Additional clarification is requested.

Claim Rejections - 35 USC § 102 and 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 54- 55, 57-58, 61-62, 65-72 is/are rejected under 35 U.S.C. 102(b) as anticipated by McMillan (5797134) or, in the alternative, under 35 U.S.C. 103(a) as obvious over McMillan in view of Butler (Driver Record: a Political Red Herring That Reveals the Basic Flaw in Automobile Insurance Pricing).

As per claim 54, McMillan teaches a method (Abstract) capable of providing motor vehicle (reads on "a property") insurance (column 1 line 13-14), comprising:

(a) identifying an applicant for insurance (reads on "receiving a request") (column 1 line 15-16);

(b) classifying the vehicle is to be used for business or non-business (reads on "an intended use") (column 2 line 28);

(c) gathering relevant historical data from the applicant (column 1 line 14-15), wherein the relevant historical data comprises manufacturer and model (column 1 line

30) (It is noted that the applicant is considered to be a “sensor” capable of providing data related to the property”);

(d) underwriting the vehicle (column 1 line 13 to column 2 line 39) based on the business or non-business use classification (reads on “use-specific underwriting guidelines”) (column 2 line 28) and the manufacturer and model of the vehicle (reads on “the collected sensor data”) (column 1 line 30);

(e) calculating a premium for the policy (reads on “offering insurance coverage”) based on underwriting (column 1 line 13 to column 2 line 39).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein. In particular, “one of” renders “denying insurance coverage” optional. See MPEP 2111.04.

The rejection presented hereinbelow is for Applicant’s consideration should Applicant adequately traverse this interpretation of the claim language.

McMillan teaches calculating surcharges to be added to the premium based on the type of use of the vehicle (column 2 line 23-39).

McMillan does not teach “denying insurance coverage”.

Butler teaches using severely expensive surcharges to refuse non-desirable customers (page 231 paragraph 4).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Butler within the embodiment of McMillan with the motivation of providing a convenient refusal price to decline coverage

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to non-desirable customers, and thereby increasing insurer profits (Butler; page 231 paragraph 4).

As per claim 55, McMillan teaches classifying the vehicle based on business or non-business use (reads on “a industry”) (column 2 line 23-28).

As per claim 57, McMillan teaches classifying the vehicle based on value of the vehicle (reads on “the condition of the property”) (column 1 line 31).

As per claim 58, McMillan teaches that it is known in the prior art to provide surcharges and discounts based on vehicle equipments (reads on “technology incorporated into the property”) (column 2 line 31-36).

The prior art as taught by McMillan does not teach "data indicating the usage of technology".

McMillan further teaches detecting data capable of indicating the status of seatbelt use (column 4 line 42).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of McMillan within the embodiment of McMillan and Butler with the motivation of accurately price insurance premiums with the actual risk associated with a particular policy (McMillan; column 2 line 40 to column 3 line 60).

As per claims 61-62, McMillan teaches an automobile (reads on “a vehicle”) (Abstract).

As per the set of claim(s): 65, 66, 67, 68, 69, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 54, 54, 54, 54, 54, respectively, and incorporated herein.

As per claim 70, McMillan teaches calculating a premium based on driver information (reads on “data generic to the insured property”, wherein a vehicle is known to be capable of being driven by any driver) (column 1 line 34-10, column 2 line 37-39).

As per claims 71-72, these claims are rejected for substantially the same rationale as applied to claim 54 above, and incorporated herein.

In particular, McMillan teaches that using memory and computers to process insurance data is old and well established in the art. See MPEP 2106.01.

Claim(s) 56, 59-60, 63-64 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan, or in the alternative, McMillan in view of Butler, as applied to parent claim 54 above, and further in view of Applicant Admitted Prior Art (AAPA) and Official Notice.

As per claim 56, McMillan and Butler do not teach “an SIC code”.

AAPA teaches that using standard industrial codes to describe the insured's operation is old and well established in the art (Specification; page 26 line 17-18).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of AAPA within the embodiment of McMillan and Butler with the motivation of providing a convenient and standardized technique to specify the insured's industry.

Notwithstanding the above, Official Notice is taken that using standard industry codes (SIC) is old and well established in the art of insurance.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of the Official Notice within the embodiment of McMillan and Butler with the motivation of providing a convenient and standardized technique to specify the insured's industry.

As per claims 59-60, 63-64, McMillan teaches using sensors to monitor the actual usage of an insured property, i.e. an automobile, to accurately price the premium of an insurance policy (Abstract and throughout).

McMillan and Butler do not teach "goods", "a building", "a boat", and "an airplane".

AAPA teaches that providing insurance for goods, buildings, marine vessels (reads on "a boat"), and aircraft (reads on "an airplane") are old and well established in the art (Specification; page 5 line 22 to page 6 line 34).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of AAPA within the embodiment of McMillan and Butler. Using the known technique of providing sensor data on an insured property for accurately pricing insurance coverage of McMillan would have been obvious to one of ordinary skill in the art.

Notwithstanding the above, Official Notice is taken that providing insurance for goods, buildings, marine vessels, and aircraft is old and well established in the art of insurance.

Furthermore, Official Notice is taken that marine vessels and aircraft, species of an "automobile", are old and well established forms of transportation.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of the Official Notice within the embodiment of McMillan and Butler. Using the known technique of providing sensor data on an insured property for accurately pricing insurance coverage of McMillan would have been obvious to one of ordinary skill in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Riegel (Insurance principle and practices) teaches standard insurance practices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./
Examiner, Art Unit 3626
03/27/2008

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626